

REMARKS

Claims 40-42, 45-49, 52 and 53 are pending in the application. Claims 40 and 47 have been amended. Care has been taken to avoid the introduction of new matter.

In the Office Action, claim 40 was objected to because of a typographical error. Claim 40 has been amended as suggested by the Examiner to correct the error. Applicant believes this amendment is fully responsive to the Examiner's concerns.

Claims 40- 42, 45-49, 52 and 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,995,942 (Smith) in view of U.S. Patent 6,484,146 (Day). This rejection is respectfully traversed. Applicant requests reconsideration and allowance of the claims in view of the following arguments.

The Examiner acknowledges that Smith fails to teach a reusable printed promotion carrier and "the data signal contains a promotion carrier data signal bearing information indicative of an identity of the promotion carrier presented to the reading device, and the computer facility determines if there are valid promotions contained on the promotion carrier" and "the computer facility determines if a detected promotion on the promotion carrier has already been presented in a completed transaction, and identifies the detected promotion as a valid promotion if it has not already been presented in a completed transaction." Day is relied upon to teach detecting and avoiding double couponing (column 6, line 55-column 7, line 10). The Examiner maintains that it would have been obvious to a person of ordinary skill in the art to combine the Smith and Day references to meet the terms of the claims.

Regarding independent claims 40 and 47, the Examiner further contends (at paragraph 5 of the Office Action) that these claims "do not recite any particular steps that lead to the promotion being reusable." Applicant disagrees because, as pointed out at page 8 of Applicant's

June 30, 2005 Amendment, the recitation appearing in claims 40 and 47 that “the printed promotion carrier being presented by the specific customer when used for each of the plurality of promotions for sale of the product” clearly delineates that the printed promotion carrier will be presented each time it is used for each of the plurality of promotions for sale of the (single) product (i.e., it is reusable).

Nevertheless, independent claim 40 has been amended for clarity to affirmatively recite that the computer facility is configured such that the printed promotion carrier is presentable by the specific customer when used for each of the plurality of promotions for sale of the product. Independent claim 47 has likewise been amended to affirmatively recite the step of presenting the printed promotion carrier, by the specific customer, when used for each of the plurality of promotions for sale of the product. No new matter has been added, since these limitations already appeared in the claims, and have simply been clarified. It is clear in amended claims 40 and 47 that the printed promotion carrier will be presented *each time* it is used for each of the plurality of promotions for sale of the (single) product.

The initial burden of establishing a *prima facie* case of obviousness is always upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In rejecting a claim under 35 U.S.C. §103, the Examiner must provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by *Graham v. John Deere Co.*, 86 S.Ct. 684, 383 U.S. 117, 148 USPQ 459, 469 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify

an applied reference and/or to combine applied references to arrive at the claimed invention.

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

In the present case, neither of the cited references, alone or in combination, teaches the computer facility of amended claim 40 configured such that the printed promotion carrier is presentable by the specific customer for each of the plurality of promotions for sale of the product, or the analogous step of amended method claim 47. Smith teaches that “[o]nce the scanner 102 scans the savings sheet, a signal is sent via the communication lines to the network interface or computer 18 to identify the document and *to cancel the document so that it can not be used a second time.*” (See, Smith, col. 7:63-66). Day teaches the avoidance of “double couponing”, as pointed out in the Office Action. Thus, the references teach or suggest that a coupon can be used only once, in contrast to the promotion carrier of amended independent claims 40 and 47.

Since neither Smith nor Day teaches or suggests the recited computer facility of amended claim 40, or the “presenting” step of amended claim 47, any combination of Day and Smith, however made, would still be missing this claimed feature. Moreover, it would not have been obvious to modify any Smith/Day combination to yield the invention of amended claims 40 and 47. Given the disclosure of both Smith and Day of coupons that cannot be used more than once, it is unrealistic to contend that one having ordinary skill in the art would somehow have been impelled to add a reusable printed promotion carrier and then apply this to the dispensed offer/savings sheet (Fig. 6) disclosed by Smith. In this regard, the Examiner should note that it is well settled that one having ordinary skill in the art can not be presumed motivated to modify a reference in a manner inconsistent with the disclosed function. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). The only apparent motivation of record for the proposed

modification of the dispensed offer/savings sheet (Fig. 6) disclosed by Smith to arrive at the claimed inventions is found in Applicant's disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987).

Regarding the recitation "the computer facility determines if a detected promotion on the promotion carrier has already been presented in a completed transaction, and identifies the detected promotion as a valid promotion if it has not already been presented in a completed transaction", as noted, the Examiner asserts that "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to identify promotions as valid if not already presented in Smith in order to allow a household to participate in the reward offer while preventing double couponing (using the same offer more than once)."

However, this is not how Day operates. It is described at col. 5:27-42 of Day:

In operation, a customer sets up an account with a store and receives one of the cards 22. Then, *whenever the customer goes shopping, he or she goes to one of the kiosks before beginning shopping and presents the card 22 to the customer interface 28*. The store level computer 12 includes means for accessing information about the special offers available to the customer associated with the card, and generates a customized list of special offers available to that particular customer. More particularly, *the computer 12 determines what special offers are available to this customer, and sends a list of special offers to the offer communicator 32. The customer then has a shopping list of special offers to use while shopping*. The customer does not engage in any selection process, but instead is quickly processed at the kiosk. *The customer then has a limited time, e.g. 3 hours, to take advantage of the special offers before they expire*. (Emphasis Added)

It is further described at col. 6:50 to col. 7:10 of Day:

After the customer finishes shopping, the customer presents his or her card 22 to the check-out 34, where the card 22 is scanned before or while purchases are rung up. The system 10 includes means for associating a purchased product with a customer account if one of the cards 22 is scanned by the bar code reader 36 in sequence with scanning of products. More particularly, a

list of all products for which special offers exist for at least one customer is downloaded from the store level computer to the check-out 34 at appropriate times, after special offer programs are initiated. *The check-out 34 then has a list of all products for which discounts may be available to certain customers. If a customer purchases a product which is included in this list, the check-out 34 communicates with the store level computer 12 to determine if a special offer is available to the particular customer whose card 22 was scanned by the check-out 34 in sequence with the products, and to determine the value of the special offer for this customer. The check-out 34 applies any special offers available to that customer to the customer's total if the customer purchased products for which special offers were available to the customer.* In one embodiment, if a product that is currently on promotion to at least one customer is scanned at the check-out 34 before the customer's card 22 is scanned, the check-out register 34 communicates the purchase to the store level computer 12 but does not necessarily wait for a response from the store level computer 12. If or when the customer card 22 is finally scanned at the check-out register 34 as part of the shopping trip, the check-out 34 communicates the card number of the customer card 22 to the store level computer 12. The store level computer 12 then communicates to the check-out register 34 each discount that the consumer qualified for because of the product purchases made in this shopping trip prior to the scan of the customer card 22. Subsequent discounts are then received by the check-out 34 immediately following the scan of a qualifying product, as previously presented.

Special offers that were accepted by the customer, and that are restricted to a certain quantity of product, will not be available to the customer the next time the customer accesses the kiosk 26 if the quantity limit has been reached. Thus, double couponing (where a customer uses the same coupon in different stores to avoid quantity limits) is avoided. The check-out sends to the computer 12 information regarding all purchases made by the customer.

Optionally, members of a household could be treated as a single customer, so that they can take advantage of combined purchasing power. The members of the household would then all have cards associating them with the same customer account in the computer 12. The computer 12 identifies which customers should be treated as a household, such as if two customers have the same address. Thus, the two customers that should belong to the same household can optionally be given the option of being treated as a household. Members of a same household may opt out of being treated as a single household. (Emphasis Added)

Thus, after a customer purchases a certain quantity of a product, double couponing is prevented by the store level computer preventing the kiosk 26 from including that product on the dispensed customer's shopping list of special offers to use while shopping when the customer next accesses the kiosk for the list of special offers. This is different from "the computer facility

determines if a detected promotion on the promotion carrier has already been presented in a completed transaction, and identifies the detected promotion as a valid promotion if it has not already been presented in a completed transaction.” In Day, only valid special product offers are included on the customer’s shopping list. Also, the customer’s shopping list of special offers is never presented to a reading device for reading a machine readable code on the shopping list associated with each product having a special product offer.

It is contended at page 6 of the Office Action that Day teaches, at col. 6:56-57, “a system that verifies if a coupon is presented twice to avoid double couponing.” However, this is not correct. Day does not teach verifying if a *coupon* is presented twice. As discussed immediately above, Day teaches that quantity-restricted special offers that were accepted by the customer are not available to the customer the next time the customer accesses kiosk 26. Day does not need to check a presented coupon to prevent double-couponing, because the kiosk 26 *does not include a product not eligible for a discount* on the dispensed customer’s shopping list of special offers.

Also, as noted above with respect to Smith, “[o]nce the scanner 102 scans the savings sheet, a signal is sent via the communication lines to the network interface or computer 18 to identify the document and *to cancel the document so that it can not be used a second time.*” More specifically, once the sheet (Fig. 6) of Smith is used, it cannot be reused so that it is the sheet of promotions for the customer that is no longer valid, not a particular promotion associated with a particular product.

Thus, as noted in the previous response, neither Smith nor Day, taken alone or in combination, disclose or suggest a system or a method of providing promotions in which it is determined if a detected promotion on the printed promotion carrier has already been presented, and the promotion is identified as a valid promotion if it has not already been presented.

Consequently, amended independent claims 40 and 47 are patentable, as are claims 41, 42, 45, 46, 48, 49, 52 and 53, which depend from claims 40 and 47, respectively.

Further regarding dependent claims 47 and 53, neither of the applied prior art references discloses or suggests determining predetermined aspects of the use of the promotion carrier including identities of each product of the completed transaction ***and at least one of the total charged amount for the completed transaction exceeding a predetermined value, each product of the completed transaction providing a profit exceeding a predetermined money amount and each product of the completed transaction providing a profit exceeding a predetermined percentage.*** It is contended in the Office Action that it would have been obvious to calculate the above information in view of Smith's teaching of data collection. Specifically, it is alleged that it would have been obvious to adjust the targeting of promotions based on the sales volume (and commensurate profit) of individual products. However, there is no support offered for the Examiner's contentions. Without such support, the contentions are mere speculation, and cannot support an obviousness rejection. Therefore, the obviousness rejection of claims 47 and 53 is improper and should be withdrawn.

Consequently, claims 47 and 53 are further and separately patentable.

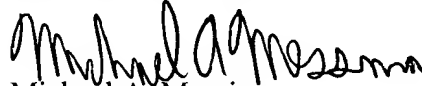
Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

09/610,216

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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